

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT 3643**

EXAMINER: Son T. Nguyen
APPELLANT: Ali Nilforushan
SERIAL NO: 10/559860
FILED: December 6, 2005
FOR: Animal Cover Having a Temperature Altering Device

MS Appeal Brief – Patents
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

APPELLANT’S REPLY BRIEF UNDER 37 CFR §41.41

This brief responds to the Examiner’s Answer dated August 20, 2010. Please charge any additional fees or credit any overpayment to our deposit account.

This brief contains the following items under the headings in the order here indicated:

- I. Status of the Claims
- II. Grounds of Rejection to be Reviewed on Appeal
- III. Argument
- IV. Claim Appendix

I. Status of Claims

1. Claims pending: 61-68 and 70-75;
2. Claims rejected: 61-68 and 70-75;
3. Claims cancelled: 1-60 and 69;
4. Claims on appeal: 61-68 and 70-75.

II. Grounds Of Rejection To Be Reviewed On Appeal

1. Rejection of claims 61, 63, 67, 70, and 72-75 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) (See final office action, page 2).
2. Rejection of claims 62 and 66 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Newman (US Pat. No. 5271211) (See final office action, page 6).
3. Rejection of claim 64 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Fazio (US Pat. No. 6443101) (See final office action, page 6).
4. Rejection of claim 65 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Beeghly et al. (US Pat. No. 5537954) (See final office action, page 7).
5. Rejection of claim 68 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Schulte (DE Pat. Appl. No. 4140507) (See final office action, page 8).
6. Rejection of claim 71 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Longtin (US Pat. Appl. No. 2003/0061790) (See final office action, page 8).

III. Argument

A. Rejection Of Claims 61, 63, 67, 70, And 72-75 Under 35 U.S.C. 103(a) As Being Obvious Over Uhr In View Of Taudauchi Et Al., Wilson, And Osborn

Claims 61, 63, 67, 70, and 72-75 were rejected under 35 U.S.C. 103(a) as being obvious over Uhr, in view of Taudauchi et al., Wilson, and Osborn. In order to support a conclusion that a claim is obvious because it is the combination of known elements, the Office must show: (i) all the claimed elements were known in the prior art, (ii) one skilled in the art could have combined the prior art elements using known methods with no change in their respective functions, (iii) the combination yielded nothing more than predictable results, and (iv) there was a reason to combine the prior art references. MPEP § 2143 (2100-129). Even post KSR, the office is reminded that "...[I]n formulating a rejection under 35 U.S.C. 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed..." (USPTO Memorandum of May 3, 2007 from Deputy Commissioner Foccarino to TC directors). The Office has failed to carry its burden of establishing a *prima facie* case of obviousness.

First, the Office has failed to show how all limitations of the claim were known in the prior art. Specifically, the Office has failed to show a blanket having a flap for applying a temperature altering regimen to a stifle joint of a horse. The Office relied on Osborn, which teaches a blanket having a flap for securing the blanket to a horse. Neither Osborn, nor any other reference cited by the Office teaches a flap having a pocket for applying a temperature altering regimen to the stifle joint of a horse. The design requirements of a flap for securing a blanket to an animal are not necessarily the same as the design requirements of a flap for applying a temperature altering regimen to the stifle joint. It would not be obvious to include a pocket on a flap where the flap is not sized and dimensioned to completely cover the stifle joint and form-fit over the joint. The appellant's invention provides a horse blanket that has freely positionable pockets for delivering a temperature altering regimen and a flap that is appropriately sized and dimensioned for receiving one of the repositionable pockets for treating the stifle joint. This unique combination of features was not known prior to the appellant's invention, which is why appellant's horse blanket has enjoyed significant commercial success. The Office failed to cite a

reference that teaches a blanket having a flap that can receive a freely positionable pocket for applying a temperature altering regimen to the stifle joint of a horse. Thus, the combination of the cited references is improper.

Second, the Office has failed to identify the reason why a person of ordinary skill in the art would have combined the prior art references. The Office simply stated that it would have been obvious to combine the prior art references, without ever identifying a reason for the combination. Merely citing function as the reason to combine the references does not provide a proper showing of teaching, suggestion, or motivation to combine. In the instant case, the Office cites Uhr, in combination with Taudauchi, Wilson, and Osborn. Both Taudauchi and Wilson address the same problem and convey to one of ordinary skill in the art that they are a complete solution to the problem. One of ordinary skill in the art would have no reason to combine two references that address the same problem and are complete solutions to the problem. Further, Osborn merely teaches a flap and does not teach a flap suitably configured to receive a pocket for delivering a temperature altering regimen to the stifle joint. The Office has failed to state a reason for combining the cited references and thus that combination is improper.

In sum, the proposed combination of the four references is improper because the Office fails to identify a sufficient teaching, suggestion, or motivation to combine the various references. Further, the Office has not shown that all the claimed elements were known in the prior art.

B. Rejection of claims 62 and 66 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Newman

Claims 62 and 66 were rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Newman (US Pat. No. 5271211) (See final office action, page 6).

As claims 62 and 66 are dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claims 62 and 66 should be withdrawn.

C. Rejection of claim 64 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Fazio

Claim 64 was rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Fazio (US Pat. No. 6443101) (See final office action, page 6).

As claim 64 is dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claim 64 should be withdrawn.

D. Rejection of claim 65 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Beeghly et al.

Claim 65 was rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Beeghly et al. (US Pat. No. 5537954) (See final office action, page 7).

As claim 65 is dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claim 65 should be withdrawn.

E. Rejection of claim 68 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Schulte

Claim 68 was rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Schulte (DE Pat. Appl. No. 4140507) (See final office action, page 8).

As claim 68 is dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claim 68 should be withdrawn.

F. Rejection of claim 71 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Longtin

Claim 71 was rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Longtin (US Pat. Appl. No. 2003/0061790) (See final office action, page 8)

As claim 71 is dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claim 71 should be withdrawn.

CONCLUSION

Claims 61-68 and 70-75 are pending in this application. In its obviousness rejections, the Office fails to show how all the claimed elements were known in the prior art. Further, even if the Office had shown all the elements were known, the Office fails to identify the reason why a person of ordinary skill in the art would have combined the prior art. Thus, all of the rejections should be withdrawn.

Respectfully submitted,

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IV. CLAIMS APPENDIX

1-60. (Canceled)

61. A temperature altering system, comprising:

a blanket sized and dimensioned to drape over a horse;

first and second pockets disposed on an underside of the blanket, each of which has a cavity that includes a removable temperature altering device, and each of which is freely positionable about the blanket using hook and loop fasteners, wherein the first pocket has a first size and the second pocket has a second size that is different from the first size; and

a flap coupled to the blanket, wherein the flap includes another pocket positioned to deliver a temperature altering regimen to a stifle joint of the horse.

62. The system of claim 61, wherein the underside of the blanket includes a wicking material.

63. The system of claim 61, wherein the first pocket has a flap disposed to assist in keeping a corresponding one of the temperature altering devices within a cavity of the first pocket.

64. The system of claim 61, wherein the first pocket has a zipper disposed to assist in keeping a corresponding one of the temperature altering devices within a cavity of the first pocket.

65. The system of claim 61, wherein the first pocket has a button disposed to assist in keeping a corresponding one of the temperature altering devices within a cavity of the first pocket.

66. The system of claim 61, wherein the first pocket has a temperature reflective material on a side adjacent the blanket.

67. The system of claim 61, wherein the pockets mate with a top side of the blanket.

68. The system of claim 61, wherein the temperature altering device is a series of electrically controlled heating elements.

69. (Canceled)

70. The system of claim 61, wherein the blanket further comprises a leg flap coupled to a rear portion of the blanket, and including an additional pocket.

71. The system of claim 61, wherein the blanket further comprises a detachable neck protrusion, wherein the protrusion includes an additional pocket.

72. The system of claim 61, wherein the blanket further comprises a front end and a rear end, wherein the front end includes a cut away portion that rests just above a withers region of the horse, and wherein the rear end of the blanket covers a horse's hindquarter region. .

73. The system of claim 61, wherein the first size and dimension of the first pocket is configured to contact the horse's spinal muscles.

74. The system of claim 61, wherein the second size and dimension of the second pocket is configured to contact at least one of the horse's shoulder and hip muscles.

75. The system of claim 61, wherein the blanket further comprises a row of fixed pockets positioned to deliver the temperature altering regimen to a horse's spinal muscles.